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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,451	03/15/2004	Yunus Mohammed	MS1-1845US	3245
22801	7590	09/12/2006	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			LU, KUEN S	
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/801,451		MOHAMMED ET AL.	
	Examiner		Art Unit	
	Kuen S. Lu		2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>15 March 2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Action is responsive to Applicant's Application filed March 15, 2004. Please note Claims 1-32 are pending.

Information Disclosure Statement

2. Information Disclosure Statements filed March 15, 2004 is considered and corresponding PTO-1449 is electronically signed and attached.

Drawings

3. The drawings, filed March 15, 2004, are considered in compliance with 37 CFR 1.81 and accepted.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 4.1. As set forth in MPEP 2106 (II) (A):

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

4.2. Claims 15-32 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 16, the claimed invention represents an apparatus for notifying user of domain activation comprising of software modules to perform functional steps. However, the apparatus does not have any hardware for supporting to perform the steps. The steps comprised in the apparatus are abstract because no concrete, useful or tangible result ensued from the intentional steps. However, a tangible, concrete and useful result is required in a practical application test. The consequence is non-statutory.

As per claim 31, the claimed invention represents an apparatus for notifying user of domain activation comprising of means for performing functional steps. However, the apparatus does not have any hardware for supporting to perform the steps. Further, the Specification does not show any evidence of providing hardware in supporting means for performing the designated functional steps. The means for comprised in the apparatus are abstract because no concrete, useful or tangible result ensued from the means for performing the functional steps. However, a tangible, concrete and useful result is required in a practical application test. The consequence is non-statutory.

As per claims 17-29, the claims inherit the deficiency of being non-statutory from claim 16, and do not remedy the deficiency individually or by inheritance. The consequence is non-statutory.

As per claims 15, 30 and 32, the claims are directed to computer readable medium including machine readable instructions. However, "computer readable medium including machine readable instructions" comprises wireless telecommunication signals and carrier waves, forms of energy. As forms of energy, the signals and waves are not a matter, composition of matter or product; and do not fall within any one of categories of patentable subject matter. For further rejecting the claims under 35 USC §102 or 35 USC §103, Examiner interprets "computer readable medium" as "computer readable storage medium".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5.1. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burstein et al. (U.S. Patent 7,076,541, hereafter "Burstein") in view of Colvig et al. (U.S. Patent Application 2004/0133664, hereafter "Colvig").

As per claim 1, Burstein teaches "A method of notifying a user of the activation of a domain" (See Col. 3, lines 15-41 where request for domain change information is received, extracted, processed and responded), comprising:
"receiving a domain change request from a requesting entity" (See Col. 8, lines 25-40 where operator enters domain change request text which is received by the front-end server of a domain server); and
"logging information obtained from the domain change request" (See Col. 8, lines 37-44 where the front-end server of the domain server parses message text received, extracts information from the text and generates a change request command).

Burstein does not explicitly teach "monitoring a change implementation entity to determine when a domain specified in the domain change request has become active", although Burstein teaches gathering information about identity of active domain name at col. 7, lines 58-62.

However, Colvig teaches monitoring and determining IP address change by pinging a server using a first IP address at Fig. 4, elements 425-440 and Page 4, [0052]-[0054].

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine the teaching of Colvig with Burstein reference by implementing facility to monitor connectivity of changed domain name because both references are directed to managing internet entity changes where Colvig teaches IP address change while Burstein focuses on domain name change, and the combined teaching of the references would have equipped Burstein's shared registry system with monitoring functionality to further facilitate the updating of domain name

and IP address, and identification of successful registered entries to the registry where the functionality is desired in a system managing a plurality of domain names for a plurality of different registrants. (See BACKGROUND OF THE INVENTION of the two references).

The combined teaching of the Colvig and Burstein references further teaches "sending a notification to a recipient entity when the domain has been determined to become active" (See Colvig: Fig. 4, elements 4450 and Page 4, [0054] where user is indicated to that the server has switched to the new IP address, and Burstein: col. 14, lines 43-48 where back-end server sends information about validated change of an identity of the authorized domain name servers to an operator via front-end server).

As per claim 16, Burstein teaches "An apparatus for notifying a user of the activation of a domain" (See Col. 3, lines 15-41 where request for domain change information is received, extracted, processed and responded), comprising:

"interface logic configured to receive a domain change request from a requesting entity" (See Col. 8, lines 25-40 where operator enters domain change request text which is received by the front-end server of a domain server); and

"monitoring setup logic configured to log information obtained from the domain change request" (See Col. 7, lines 51-53 and col. 8, lines 37-44 where the front-end server of the domain server parses message text returned by an operator, extracts information from the text and generates a change request command).

Burstein does not explicitly teach “monitoring logic configured to monitor a change implementation entity to determine when a domain specified in the domain change request has become active”, although Burstein teaches gathering information about identity of active domain name at col. 7, lines 58-62.

However, Colvig teaches monitoring and determining IP address change by pinging a server using a first IP address at Fig. 4, elements 425-440 and Page 4, [0052]-[0054].

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine the teaching of Colvig with Burstein reference by implementing facility to monitor connectivity of changed domain name because both references are directed to managing internet entity changes where Colvig teaches IP address change while Burstein focuses on domain name change, and the combined teaching of the references would have equipped Burstein's shared registry system with monitoring functionality to further facilitate the updating of domain name and IP address, and identification of successful registered entries to the registry where the functionality is desired in a system managing a plurality of domain names for a plurality of different registrants. (See BACKGROUND OF THE INVENTION of the two references).

The combined teaching of the Colvig and Burstein references further teaches “notification logic configured to send a notification to a recipient entity when the domain has been determined to become active” (See Colvig: Fig. 4, elements 4450 and Page 4, [0054] where user is indicated to that the server has switched to the new IP address, and Burstein: col. 14, lines 43-48 where back-end server sends information about

validated change of an identity of the authorized domain name servers to an operator via front-end server).

As per claim 31, Burstein teaches "An apparatus for notifying a user of the activation of a domain" (See Col. 3, lines 15-41 where request for domain change information is received, extracted, processed and responded), comprising:

"means for receiving a domain change request from a requesting entity" (See Col. 8, lines 25-40 where operator enters domain change request text which is received by the front-end server of a domain server); and

"means for logging information obtained from the domain change request" (Col. 8, lines 37-44 where the front-end server of the domain server parses message text received, extracts information from the text and generates a change request command).

Burstein does not explicitly teach "means for monitoring a change implementation entity to determine when a domain specified in the domain change request has become active", although Burstein teaches gathering information about identity of active domain name at col. 7, lines 58-62.

However, Colvig teaches monitoring and determining IP address change by pinging a server using a first IP address at Fig. 4, elements 425-440 and Page 4, [0052]-[0054].

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine the teaching of Colvig with Burstein reference by implementing facility to monitor connectivity of changed domain name because both references are directed to managing internet entity changes where Colvig

teaches IP address change while Burstein focuses on domain name change, and the combined teaching of the references would have equipped Burstein's shared registry system with monitoring functionality to further facilitate the updating of domain name and IP address, and identification of successful registered entries to the registry where the functionality is desired in a system managing a plurality of domain names for a plurality of different registrants. (See BACKGROUND OF THE INVENTION of the two references).

The combined teaching of the Colvig and Burstein references further teaches "means for sending a notification to a recipient entity when the domain has been determined to become active" (See Colvig: Fig. 4, elements 4450 and Page 4, [0054] where user is indicated to that the server has switched to the new IP address, and Burstein: col. 14, lines 43-48 where back-end server sends information about validated change of an identity of the authorized domain name servers to an operator via front-end server).

As per claims 2 and 17, the combined teaching of the Colvig and Burstein references further teaches "the domain change request instructs the change implementation entity to create a new domain name" (See Burstein: col. 3, lines 1-5 where an entry of domain name is created to the shared registry).

As per claims 3 and 18, the combined teaching of the Colvig and Burstein references further teaches "the domain change request instructs the change implementation entity

to update an existing domain name” (See Burstein: col. 4, lines 39-42 where registrants registering new domain name, maintaining domains and updating domain information).

As per claims 4 and 19, the combined teaching of the Colvig and Burstein references further teaches “the logging of information obtained from the domain change request includes recording a domain name identified in the domain change request” (See Burstein: col. 3, lines 28-32 where domain name information is extracted from request message).

As per claims 5 and 20, Colvig does not explicitly teach “the logging of information obtained from the domain change request includes recording a time stamp that is related to a time at which the domain change request was made”.

However, Burstein teaches recording registry system update time stamp at Fig. 4.

It would have been obvious to one having ordinary skill in the art at the time of the applicant’s invention was made to include time stamp data of the request because recording timestamp of transaction is such a popular practice that internet transaction log normally contains timestamp information of user’s each transaction.

As per claims 6 and 21, the combined teaching of the Colvig and Burstein references further teaches “the logging of information obtained from the domain change request includes recording a notification address used to send the notification to the recipient entity” (See Burstein: col. 14, lines 43-48 where back-end server sends information

about validated change of an identity of the authorized domain name servers to an operator via front-end server).

As per claims 7 and 22, the combined teaching of the Colvig and Burstein references further teaches "the logging of information obtained from the domain change request includes recording an updated name server address associated with the domain specified in the domain change request" (See Burstein: col. 7, lines 5-11 where server provides domain name update information to domain registration system for updating the domain name).

As per claims 8 and 23, the combined teaching of the Colvig and Burstein references further teaches "the monitoring of the change implementation entity includes determining whether a predetermined time has elapsed since the domain change request was received, and if so, querying the change implementation entity" (See Colvig: Page 4, [0051] where time interval was set for pinging an IP address to determine connectivity).

As per claims 9 and 24, the combined teaching of the Colvig and Burstein references further teaches the monitoring includes determining the predetermined time by looking up the predetermined time in a configuration table" (See Colvig: Page 4, [0051] and [0056]-[0057] where time intervals were set for pinging an IP address to determine connectivity).

As per claims 10 and 25, the combined teaching of the Colvig and Burstein references further teaches “the monitoring includes sending a domain name system (DNS) request to the change implementation entity, and receiving a reply back from the change implementation entity that reflects whether the domain is active or not” (See Colvig: Fig. 4, elements 425-440 and Page 4, [0052]-[0054] where monitoring and determining IP address change is performed by pinging a server using a first IP address, and Burstein: col. 14, lines 43-48 where back-end server sends information about validated change of an identity of the authorized domain name servers to an operator via front-end server).

As per claims 11 and 26, the combined teaching of the Colvig and Burstein references further teaches “repeating the sending of a request and receiving of a reply until a reply is received that indicates that the domain is active” (See Colvig: Fig. 4, elements 425-440 and Page 4, [0052]-[0054] where monitoring and determining IP address change is performed by periodically pinging a server using a first IP address until a target stops to respond, and Burstein: col. 14, lines 43-48 where back-end server sends information about validated change of an identity of the authorized domain name servers to an operator via front-end server).

As per claims 12 and 27, the combined teaching of the Colvig and Burstein references further teaches “the reply received from the change implementation entity

provides an address of a domain name server in the domain name system” (See Colvig: Fig. 4, elements 450 and Page 4, [0054] where a new IP address is brought up).

As per claims 13 and 28, the combined teaching of the Colvig and Burstein references further teaches “a determination of whether the domain is active or not is made by comparing the address specified in the reply with a stored updated name server address, wherein the domain is determined to be active when the address specified in the reply matches the stored updated name server address” (See Colvig: Fig. 4, elements 450 and Page 4, [0054] where user is indicated to that server is bringing up TCP/IP using second IP address suggests the second address is compared and different to the first address).

As per claims 14 and 29, the combined teaching of the Colvig and Burstein references further teaches “the sending of the notification comprises sending an electronic mail message to the recipient entity” (See Colvig: Page 1, [0007]-[0008] and Page 6, [0074] where IP address information is sent and received between computers).

As per claims 15, 30 and 32, the combined teaching of the Colvig and Burstein references further teaches “A computer readable medium including machine readable instructions for implementing the receiving, logging, monitoring, and sending” (See Burstein: Col. 3, lines 15-41 and col. 6, lines 36-62 where request for domain change

information is received, extracted, processed and responded and the implementation is embodied as software residing on storage medium).

Conclusion

6. The prior art made of record

- A. U.S. Patent No. 7,076,541
- B. U.S. Patent Application 2004/0133664

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- C. U.S. Patent Application 2004/0172470
- D. U.S. Patent No. 6,965,584
- E. U.S. Patent Application 2002/0010682
- F. U.S. Patent Application 2004/0078487
- G. U.S. Patent Application 2002/0016789

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is (571) 272-4114. The examiner can normally be reached on Monday-Friday (8:00 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for Page 13

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

Kuen S. Lu



Patent Examiner, Art Unit 2167

September 8, 2006